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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/758,262 | 01/16/2004 | Kevin Sullivan | 47004.000279 | 5705 |
| 21967 7590 02/06/2007 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109 | | | EXAMINER LIVERSEDGE, JENNIFER L. | |
| | | | ART UNIT 3692 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 02/06/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/758,262

Applicant(s)

SULLIVAN, KEVIN

Examiner

Jennifer Liversedge

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/25/2004, 2/26/2004, 5/18/2004, 8/2/2005, 5/8/2006.

DETAILED ACTION

Information Disclosure Statement

The reference materials cited in the 34 pages of IDS forms were considered but given a cursory review due to the voluminous nature of the references.

Claim Objections

Claims 30-34 are objected to because of the following informalities: claims 30-34 currently depend from non-existent claim 54. For purposes of examination, Examiner will review claims 30-34 as if they depend from independent claim 29. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent; except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,895,386 B1 to Bachman et al. (further referred to as Bachman).

Regarding claim 29, Bachman discloses a computerized method comprising:

Establishing a partnership between an investment account provider and a card instrument provider for linking card instrument accounts with investment accounts, further including a rebate program funding investment accounts based on card instrument usage (column 4, line 50 – column 5, line 10);

Providing to a cardholder a co-branded card instrument with co-branded indicia of the card instrument account provider and the investment account provider (column 4, lines 50-67);

Linking the card instrument account with an investment account established by the investment account provider in the cardholder's name (column 4, line 50 – column 5, line 10);

Calculating a rebate based on card usage (column 4, line 50 – column 5, line 10);
and

Applying the rebate to the investment account (column 4, line 50 – column 5, line 10).

Regarding claim 30, Bachman discloses the method wherein the rebate is calculated periodically according to a first period; wherein an accrued rebate value is applied to the investment account according to a second period; wherein the second period is longer than the first period; thereby providing a rebate feature with an accrual and vesting periods which encourage cardholders to maintain their card instrument account (column 7, lines 9-27; column 9, lines 17-24; column 13, lines 25-30).

Regarding claim 31, Bachman discloses wherein the card instrument account and the investment account are linked when the card instrument account is established (column 4, lines 50-57).

Regarding claim 32, Bachman discloses wherein the card instrument account and the investment account are linked after the card instrument account is established and the cardholder has used the card (column 9, lines 17-24).

Regarding claim 33, Bachman discloses wherein the card instrument account is linked with an investment account newly created by the investment account provider for the co-branded instrument (column 5, lines 50-54).

Regarding claim 34, Bachman discloses wherein the card instrument account is linked with a preexisting investment account (column 4, lines 61-67).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent Nos. 6,243,688 B1 and 5,970,480 to Kalina wherein at least all the limitations of independent claim 29 are found.

U.S. Patent No. 6,345,261 B1 to Feidelson et al. wherein at least all the limitations of independent claim 29 are found.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at 571-272-6777. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge
Examiner
Art Unit 3692



RICHARD E. CHILCOT, JR.
SUPERVISORY PATENT EXAMINER